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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,417	08/24/2004	Hiroshi Kaneta	8017-1141	7384
<small>465</small> YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			<small>7590</small> EXAMINER LEE, CYNTHIA K	
			<small>04/03/2009</small> ART UNIT 1795	PAPER NUMBER
			MAIL DATE 04/03/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/505,417

Applicant(s)

KANETA ET AL.

Examiner

CYNTHIA LEE

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-8 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-8 and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Appeal Brief

In view of the Appeal Brief filed on 8/24/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

DETAILED ACTION

This Office Action is responsive to the Appeal Brief filed on 11/24/2008. Claims 2,3,5-8, and 11-21 are pending. Applicant's arguments have been fully considered and are persuasive. However, upon further consideration, the instant claims are rejected under new grounds of rejections. Claims 2,3,5-8, and 11-21 are non-finally rejected for reasons stated herein below.

Claims Analysis

The recitation "secondary" in the limitation "secondary battery" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See MPEP 2111.02.

It is noted a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference.

The limitation "for charging and discharging" has been considered but was not given patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987). See MPEP 2114.

Information Disclosure Statement

The Information Disclosure Statement (IDS) filed 9/8/2008 has been placed in the application file and the information referred to therein has been considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6, 8, and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aamodt (US 2003/0194604).

Refer to fig. 1. Aamodt discloses a flat battery comprising an electric-power generating element provided with positive and negative electrode collectors, each of said collectors having a respective uncoated area that is free of active material;

a third terminal that is attached directly to said uncoated area of one of said positive and negative electrode collectors and that does not directly contact either of said positive and negative electrode terminals,

wherein said third terminal and a respective one of said positive and negative electrode terminals are attached to said uncoated area of said one collector of said positive and negative electrode collectors at different positions in order to avoid an influence on said third terminal of heat from the respective one of said positive and negative electrode terminals, and

wherein said third terminal has a same electric potential as said respective one of said positive and negative electrode terminals and said third terminal is attached electrically conductively to said uncoated area of said one of said positive and negative electrode collectors.

Aamodt discloses a negative electrode terminal attached to said uncoated area of the negative electrode collector, but does not disclose the positive electrode terminal attached to said uncoated area of the negative electrode collector (Applicant's claim 21). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made configure the positive terminal similarly to the negative terminal attached to the uncoated area of the current collector for the benefit of directly attaching the terminal to the current collector.

Regarding claims 2 and 3, it would have been obvious to one of ordinary skill in the art at the time the invention was made the third terminal extending in the different direction from the positive or negative terminal depending on the location of the electrical connection on the power device.

Regarding claims 5, 11, 12, 19, and 20, Aamodt discloses that the battery can be used in implantable medical devices [0024]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the third terminal to a control circuit within a implantable medical device for the benefit of monitoring the amount of power delivered to the device.

Aamodt discloses a battery but does not disclose a plurality of said battery connected serially to each other (applicant's claims 8 and 20). However, the Examiner

notes that it is common practice in the art to connect a plurality of batteries either in series or parallel to increase the voltage or the current depending on the power requirements of the intended application of the battery. It would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the battery of Takatani in series or parallel for the benefit of meeting the power requirements of the intended application

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aamodt (US 2003/0194604) as applied to claim 21, in view of Yamashita (US 6287720).

Aamodt teaches all the limitations of claim 21 and are incorporated herein. Aamodt discloses a stainless steel casing [0035], but does not disclose a laminated film casing. Yamashita teaches a battery with a casing made of various materials, such as a laminate casing, among others (10:25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the casing of laminate casing for the benefit of a light weight battery.

Response to Arguments

Applicant's arguments filed 11/24/2008 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cynthia Lee/
Examiner, Art Unit 1795

/PATRICK RYAN/
Supervisory Patent Examiner, Art
Unit 1795